

07-11-05

IFW

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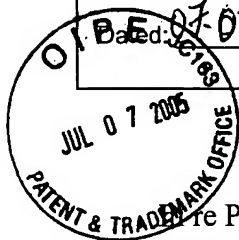
Date: 07-07-05

Signature:

(Georgina Matos)

Patent

Docket No. 399242000401



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Re Patent Application of:
Thomas J. FOGARTY et al.

Serial No.: 10/798,776

Filing Date: March 10, 2004

For: IMPROVED DEVICE FOR
ACCURATELY MARKING TISSUE

Examiner: S. Gilbert

Group Art Unit: 3736

**SUPPLEMENTAL INFORMATION DISCLOSURE
STATEMENT UNDER 37 C.F.R. § 1.97 & 1.98**

MS Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Dear Sir:

Pursuant to 37 C.F.R. §1.97 and § 1.98, Applicants submit for consideration in the above-identified application the documents listed on the attached Form PTO/SB/08a/b. Copies of foreign documents and non-patent literature are submitted herewith. The Examiner is requested to make these documents of record.

This Supplemental Information Disclosure Statement is submitted:

- ☐ With the application; accordingly, no fee or separate requirements are required.
- ☐ Before the mailing of a first Office Action after the filing of a Request for Continued Examination under § 1.114. However, if applicable, a certification under 37 C.F.R. § 1.97 (e)(1) has been provided.
- ☒ Within three months of the application filing date or before mailing of a first Office Action on the merits; accordingly, no fee or separate requirements are required. However, if applicable, a certification under 37 C.F.R. § 1.97 (e)(1) has been provided.
- ☐ After receipt of a first Office Action on the merits but before mailing of a final Office Action or Notice of Allowance.
 - ☐ A fee is required. A check in the amount of ___ is enclosed.
 - ☐ A fee is required. Accordingly, a Fee Transmittal form (PTO/SB/17) is attached to this submission in duplicate.
 - ☐ A Certification under 37 C.F.R. § 1.97(e) is provided above; accordingly, no fee is believed to be due.
- ☐ After mailing of a final Office Action or Notice of Allowance, but before payment of the issue fee.
 - ☐ A Certification under 37 C.F.R. § 1.97(e) is provided above and a check in the amount of ___ is enclosed.
 - ☐ A Certification under 37 C.F.R. § 1.97(e) is provided above and a Fee Transmittal form (PTO/SB/17 is attached to this submission in duplicate.)

Applicants would appreciate the Examiner initialing and returning the Form PTO/SB/08a/b, indicating that the information has been considered and made of record herein.

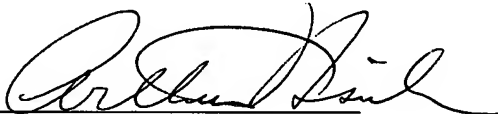
The information contained in this Supplemental Information Disclosure Statement under 37 C.F.R. § 1.97 and § 1.98 is not to be construed as a representation that: (i) a complete search has been made; (ii) additional information material to the examination of this application does not exist;

(iii) the information, protocols, results and the like reported by third parties are accurate or enabling;
or (iv) the above information constitutes prior art to the subject invention.

In the unlikely event that the transmittal form is separated from this document and the Patent and Trademark Office determines that an extension and/or other relief (such as payment of a fee under 37 C.F.R. § 1.17 (p)) is required, Applicants petition for any required relief including extensions of time and authorize the Commissioner to charge the cost of such petition and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing 399242000401.

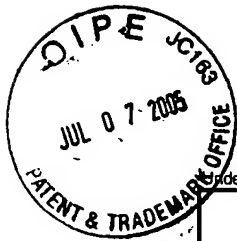
Dated: July 7, 2005

Respectfully submitted,

By 

Arthur S. Hsieh

Registration No.: 48,247
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PTO/SB/21 (09-04)

Approved for use through 07/31/2006. OMB 0651-0031

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

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TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

| | | | |
|---|------------|------------------------|-------------------|
| TRANSMITTAL FORM (to be used for all correspondence after initial filing) | | Application Number | 10/798,776 |
| | | Filing Date | March 10, 2004 |
| | | First Named Inventor | Thomas J. FOGARTY |
| | | Art Unit | 3736 |
| | | Examiner Name | S. Gilbert |
| Total Number of Pages in This Submission | 8 + 6 refs | Attorney Docket Number | 399242000401 |

ENCLOSURES (Check all that apply)

| | | |
|--|---|---|
| <input type="checkbox"/> Fee Transmittal Form | <input type="checkbox"/> Drawing(s) | <input type="checkbox"/> After Allowance Communication to TC |
| <input type="checkbox"/> Fee Attached | <input type="checkbox"/> Licensing-related Papers | <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences |
| <input type="checkbox"/> Amendment/Reply | <input type="checkbox"/> Petition | <input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) |
| <input type="checkbox"/> After Final | <input type="checkbox"/> Petition to Convert to a Provisional Application | <input type="checkbox"/> Proprietary Information |
| <input type="checkbox"/> Affidavits/declaration(s) | <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address | <input type="checkbox"/> Status Letter |
| <input type="checkbox"/> Extension of Time Request | <input type="checkbox"/> Terminal Disclaimer | <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): |
| <input type="checkbox"/> Express Abandonment Request | <input type="checkbox"/> Request for Refund | 1. PTO Form SB/08a/b + copy (4 pages) |
| <input checked="" type="checkbox"/> Information Disclosure Statement, Supplemental (3 pages) | <input type="checkbox"/> CD, Number of CD(s) _____ | 2. Six (6) References |
| <input type="checkbox"/> Certified Copy of Priority Document(s) | <input type="checkbox"/> Landscape Table on CD | 3. Return Receipt Postcard |
| <input type="checkbox"/> Reply to Missing Parts/Incomplete Application | Remarks | |
| <input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53 | | |

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

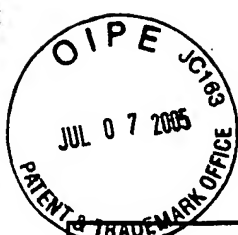
| | | | |
|--------------|--|----------|--------|
| Firm Name | MORRISON & FOERSTER LLP (Customer No. 25226) | | |
| Signature | | | |
| Printed name | Arthur S. Hsieh | | |
| Date | July 7, 2005 | Reg. No. | 48,247 |

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Dated: July 7, 2005

Signature:

(Georgina Matos)



ALTERNATIVE TO PTO/SB/08a/b (06-03)

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|--|---|----|---|--------------------------|-------------------|
| Substitute for form 1449/PTO INFORMATION DISCLOSURE STATEMENT BY APPLICANT (Use as many sheets as necessary) | | | | Complete if Known | |
| | | | | Application Number | 10/798,776 |
| | | | | Filing Date | March 10, 2004 |
| | | | | First Named Inventor | Thomas J. FOGARTY |
| | | | | Art Unit | 3736 |
| | | | | Examiner Name | S. Gilbert |
| Sheet | 1 | of | 2 | Attorney Docket Number | 399242000401 |

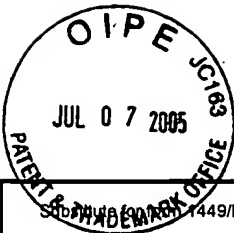
| U.S. PATENT DOCUMENTS | | | | | |
|-----------------------|--------------------------|--|--------------------------------|--|---|
| Examiner Initials* | Cite No. ¹ | Document Number | Publication Date MM-DD-YYYY | Name of Patentee or Applicant of Cited Document | Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear |
| | | Number-Kind Code ² (if known) | | | |
| | 1. | US-2002/0147444-A1 | 10-10-2002 | Shah et al. | |
| | 2. | US-2003/0109862-A1 | 06-12-2003 | Prakash et al. | |
| | 3. | US-2003/0195499-A1 | 10-16-2003 | Prakash et al. | |
| | 4. | US-2004/0267156-A1 | 12-30-2004 | Turovskiy et al. | |
| | 5. | US-2005/0062666-A1 | 03-24-2005 | Prakash et al. | |
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| | 7. | US-4,621,642 | 11-11-1986 | Chen | |
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| | 9. | US-5,405,346-A | 04-11-1995 | Grundy et al. | |
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| | 11. | US-5,599,294-A | 02-04-1997 | Edwards et al. | |
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| | 15. | US-6,056,744-A | 05-02-2000 | Edwards | |
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| | 19. | US-6,496,738-B2 | 12-17-2002 | Carr | |
| | 20. | US-6,530,922-B2 | 03-11-2003 | Cosman et al. | |
| | 21. | US-6,564,806-B1 | 05-20-2003 | Fogarty et al. | |
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| | 23. | US-6,699,241-B2 | 03-02-2004 | Rappaport et al. | |
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| FOREIGN PATENT DOCUMENTS | | | | | | |
|--------------------------|-----------------------|---|--------------------------------|---|--|----------------|
| Examiner Initials* | Cite No. ¹ | Foreign Patent Document | Publication Date MM-DD-YYYY | Name of Patentee or Applicant of Cited Document | Pages, Columns, Lines Where Relevant Passages or Relevant Figures Appear | T ⁶ |
| | | Country Code ³ -Number ⁴ -Kind Code ⁵ (if known) | | | | |
| | 28. | WO-01/60235-A3 | 08-23-2001 | Fogarty | | |
| | 29. | WO-03/039385-A2, A3 | 05-15-2003 | Vivant Medical, Inc. | | |
| | 30. | WO-03/088806-A2, A3 | 10-30-2003 | Vivant Medical, Inc. | | |
| | 31. | WO-03/088858-A1 | 10-30-2003 | Vivant Medical, Inc. | | |

*EXAMINER: Initial if information considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant. ¹ Applicant's unique citation designation number (optional). ² See Kinds Codes of USPTO Patent Documents at www.uspto.gov or MPEP 901.04. ³ Enter Office that issued the document, by the two-letter code (WIPO Standard ST.3). ⁴ For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. ⁵ Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST. 16 if possible. ⁶ Applicant is to place a check mark here if English language Translation is attached.

| | | | |
|-----------------------|--|--------------------|--|
| Examiner Signature | | Date Considered | |
|-----------------------|--|--------------------|--|

pa- 990076



ALTERNATIVE TO PTO/SB/08a/b (06-03)

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|---|---|----|---|--------------------------|-------------------|
| INFORMATION DISCLOSURE STATEMENT BY APPLICANT (Use as many sheets as necessary) | | | | Complete if Known | |
| | | | | Application Number | 10/798,776 |
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| | | | | First Named Inventor | Thomas J. FOGARTY |
| | | | | Art Unit | 3736 |
| | | | | Examiner Name | S. Gilbert |
| Sheet | 2 | of | 2 | Attorney Docket Number | 399242000401 |

| NON PATENT LITERATURE DOCUMENTS | | | | | |
|---------------------------------|-----------------------|--|--|--|----------------|
| Examiner Initials | Cite No. ¹ | Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published. | | | T ² |
| | 32. | Chou, C.K. (1995). "Radiofrequency Hyperthermia in Cancer Therapy," Chapter 94 <i>In <u>Biologic Effects of Nonionizing Electromagnetic Fields</u></i> . CRC Press, Inc. pp.1424-1428. | | | |
| | 33. | Urologix, Inc.-Medical Professionals: Targis™ Technology (Date Unknown). "Overcoming the Challenge" located at: < http://www.urologix.com/medical/technology.html > last visited on April 27, 2001. Three pages. | | | |

*EXAMINER: Initial if information considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

¹Applicant's unique citation designation number (optional). ²Applicant is to place a check mark here if English language Translation is attached.

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|-----------------------|--|--------------------|--|
| Examiner Signature | | Date Considered | |
|-----------------------|--|--------------------|--|

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